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WILLIAMS, MORGAN & AMERSON, P.C.
10333 RICHMOND AVE.
SUITE 1100
HOUSTON, TX 77042

EXAMINER
SMARTH, GERALD A

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/781,029
Filing Date: February 17, 2004
Appellant(s): STOCHOSKY, MICHAEL

_____
Jaison C. John
(Reg. No. 50737)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 5, 2008 appealing from the Office

action mailed April 29, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7080139	Briggs	7/2006
2002/0076025	Liversidge	6/2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-38 are rejected under 35 U.S.C 103(a) as being unpatentable over

Briggs et al(7080139) in view of Liversedge (2002/0076025),

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Briggs

et al (7080139) in view of Liversedge (2002/0076025),

Regarding claim 1, Brigs teaches An apparatus for sharing identity-based activity with at

least one peer, comprising: a content daemon to detect and store identity-based activity;

(Briggs discloses the present invention includes methods and devices for

passively tracking and selectively sharing user experiences with communication

devices, including computers, web-enabled telephones, and PDAs; Abstract) (Briggs

further discloses aggregation tools and processes assemble statistics about user

experiences across different bases, such as buddy lists, categories of users, and all

service participants; Page 2 lines 38-41)

and an instant messaging module, (Briggs discloses the extension following the link

may identify a particular instant messaging tool; Column 8 line 8-9) communicatively

coupled to the content daemon, (Briggs discloses each matched entry is added 1627 to

the corresponding shared users file within the activity viewer database ("AVD") 1610;

Column 13 lines 34-38) to send an indication of identity-based activity to at least one

peer, the identity-based activity related to a user logged-in to the instant messaging

module. (Briggs discloses so-called "buddies" identified on buddy lists of instant

messaging products can share selected aspects of their computer usage experiences.;

Column 2 lines 28-30) (Briggs further discloses aggregation tools and processes

assemble statistics about user experiences across different bases, such as buddy lists,

categories of users, and all service participants; Page 2 lines 38-41)

Briggs does not directly teach an instant message module.

However Liversidge does teach an instant message module. (Liversidqe discloses an

instant messaging server 84 which interacts with the collaboration manager 76 to

provide specialized services with respect to the management and control of instant

messaging sessions; Paqe 7 paragraph 73 lines 25-29)

It would be obvious to one of ordinary skill in the art before the time of the invention to

modify the method and apparatus of sharing and tracking communication device

experiences to include an instant messaging module of Liversidge. One of ordinary skill

in the art would have been motivated to make this modification in order to have a instant

messaging module to take place of the instant messaging provider such as Yahoo.

RTM, which Briggs uses. This will allow for the instant message server to be on site for

maintenance and upgrades. Furthermore, each user of the Yahoo.RTM. Messenger

service must define their own group of friends. There is no central facility for defining a

group or a team, and there is no method of controlling congruence between two groups

defined by individual users. Consequently, although Yahoo.RTM. Messenger facilitates

message exchange, it is not adapted to provide a cohesive collaboration environment

for geographically-dispersed teams working at a professional level; Page 1 paragraph 9

lines 12-19.

Thus the combination of Briggs and Liversidge teach the limitation of claim 1.

Regarding claim 4, Briggs taught the apparatus of claim 1, as described above. Briggs

further teaches wherein identity-based activity comprises instances of active content by

a user logged-in to the instant messaging module. (Briggs discloses the user selects

between sending the item, a link to the item or other item-related information to a buddy

who has enrolled to share activity data or to a person listed as an instant messaging

buddy; Column 7 line 42-44)

Regarding claim 8, Briggs taught the apparatus of claim 1, as described above. Brigs

further teaches wherein the content daemon detects and stores identity-based activity

after logging-in the user to the instant messaging module (FIG. 2 is a user interface for

logging in or creating a new account)., and wherein the instant messaging module

sends an update to the identity-based activity. (Fig 8) (Briggs discloses the columns

provided in this embodiment include a tick box 852, a buddy name 853, and one or

more instant messaging contact links 854; Column 7 line 64-65)

(10) Response to Argument

Examiner summarizes the various points raised by the appellant and addresses

them individually.

(A) Appellant Argues: Applicant brings up "instant messaging module" used in claims.

Appellant respectfully directs the Board's attention to the Specification, p. 12, ll. 15-16

(stating a "centralized messenger service may be Apple Computer Inc.'s iChat TM,

America Online's AIM TM, an instant messaging module or the like."). Further, the term

"instant messaging module" was found in the originally filed claims, which as the

Examiner is well aware, is part of the originally filed specification. Additionally,

throughout the Specification, references to instant messaging applications can be

found. Therefore, there is sufficient antecedent basis for the claimed subject matter, and

the Examiner erred in maintaining this rejection.

In the Advisory Action, the Examiner states that "Examiner is not sure what an instant

messaging module is," yet the Examiner goes on to argue that an instant messaging

module is strictly software. See Advisory Action, Continuation Sheet. Appellant

respectfully submits that without a clear understanding of what an instant messaging

module is the Examiner cannot maintain a proper basis for such arguments. As noted

above, there exists adequate support for the term "instant messaging module" in the

specification of the present application, and the Examiner's objection to the

Specification with respect to "instant messaging module" is not proper.

With respect to the claimed feature of computer-readable medium, Appellant

respectfully directs the Examiner's attention to the language of claim 26 itself: "a

computer-readable medium having computer program instructions and data embodied

thereon for sharing identity-based activity with at least one peer." Appellant submits that

a computer readable medium, by itself, shows a tangible thing. Likewise, a software

program by itself could not have instructions or data embodied thereon. This language

clearly indicates a tangible, physical embodiment, and this would be clear to those

skilled in the art having the benefit of the present disclosure.

Appellant also respectfully directs the Board's attention to the Specification, Fig. 1,

which discloses two servers (130 and 140). A person of ordinary skill in the art would

easily recognize a server as a type of computer with RAM, processor(s), disk storage,

user inputs, CD- ROMs/floppy diskette drives, and the like. Thus, those skilled in the art

would find the support for "computer readable medium" in the specification. Additionally,

Appellant respectfully directs the Board's attention to the Specification, p.15, 11. 9-15,

for textual support as a non- limiting, illustrative example. This passage states:

The content repository 240 stores data files that are activated by the application module

230. The content repository 240 may be a hard disk, flash memory, random access

memory, or any device capable of non-volatile or volatile storage of data files The data

files contain data in any useful format, such as mpg, .wma, .omg, .gif, .mp3, .doc, .txt,

.pdf, or any format capable of execution by the application module 230. In one

embodiment, the content repository 240 is networked to the sender peer 110 such as a

personal digital assistant with data files connected to the peer via the Bluetooth wireless

communications protocol.

See Specification, p. 15, 11.9-15. These exemplary references to the subject matter of

storing data would make clear to those skilled in the art the nature of a "computer

readable medium" within the context of the present invention. As such, the Specification

clearly provides support for the claimed features.

In Response: Based on argument of objection towards instant messaging module and

computer-readable medium, objection is withdrawn by examiner.

(B) Appellant Argues: The Examiner rejected claims 1-15 and 38 under 35 U.S.C.

§101 as being directed to non-statutory subject matter. Appellant respectfully traverses

this rejection.

Appellant respectfully disagrees that the claims are directed toward software as claimed

by the Examiner. See Office Action, p.3. Appellant asserts that a claim for an apparatus

which in turn uses a daemon or module is allowable subject matter under 35 U.S.C.

§101. Appellant is not seeking to patent a computer program or a module as argued by

the Examiner, rather with regard to claims 1-15 and 38, Appellant seeks to claim an

apparatus with certain features that uses a daemon/module to perform functions.

Additionally, daemons, as is known in the art, may be implemented as hardware,

software, or a combination thereof, and are not limited to any one format as suggested

by the Examiner. Moreover, the claimed features of a daemon and a module are used to

provide a useful/tangible result. For example, the daemon is used to detect and store

identity-based activity. Here the storing of identity based activity clearly meets the

requirement of a useful/ tangible result. Similarly, an instant messaging module that

sends an indication of identity-based activity to at least one peer provides a

useful/tangible result. The claims refer to an apparatus that comprises these useful

modules to perform specific processes, resulting in a novel, useful and non-obvious,

tangible apparatus.

Accordingly, claims 1-15 and 38 are in full compliance with the requirements of 35

U.S.C. §101. Therefore, Appellant respectfully requests the Examiner's rejection under

35 U.S.C. §101 be withdrawn.

In Response: In order to clarify the examiner's position, the examiner would like to explain the reasoning for the considering instant module and apparatus as software and thus the 101 rejection. Applicant explains the purpose of the invention is not to seek a patent on a computer program. Applicant explains apparatus has certain features that uses a daemon/module to perform functions. Examiner respectfully points out apparatus, module and more specifically the instant messaging module is not defined and is very briefly supported in the specification. There is no where in the specification examiner can see Instant messaging module being explained as having hardware components, thus it can be viewed as being software.

(C.1) Appellant's Argument regarding claims 1-38: Claims 1-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Briggs (US Pat. 7,080,139) in view of Liversidge (US Pub. 2002/0076025). Appellant respectfully asserts that the Examiner erred in maintaining this rejection, and requests that the Examiner's rejection be reversed.

For ease of discussion, claim 1 is discussed first. Claim 1, directed to an apparatus for sharing identity-based activity with at least one peer, calls for (1) a content daemon to detect and store identity-based activity, and (2) an instant messaging module, communicatively coupled to the content daemon, to send an indication of identity-based activity to at least one peer, the identity-based activity related to a user logged-in to the instant messaging module.

Appellant respectfully asserts that Briggs, Liversidge, and/or their combination do not teach or disclose all of the elements of claim 1 of the present invention. In order to establish a prima facie case of obviousness, the Examiner must consider the following factors: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. MPEP § 2143 (2005) (citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In making an obviousness rejection, it is necessary for the Examiner to identify the reason why a person of ordinary skill in the art would have combined the prior art references in the manner set forth in the claims. KSR Int'l Co. v. Teleflex, Inc., at 14, No. 04-1350 (U.S. 2007). Appellant respectfully submits that the Examiner has not met this burden. If, as illustrated below, Briggs and Liversidge are incompatible, then consequently those skilled in art would not combine them and make all of the elements of claims of the present invention obvious. Accordingly, Appellant respectfully submits that a primafacie case of obviousness has not been established in rejecting claims 1-38.

For example, with respect to the claimed feature of an instant messaging module, communicatively coupled to the content daemon, to send an indication of identity-based activity to at least one peer, the identity-based activity related to a user logged-in to the instant messaging module, the Examiner has admitted that Briggs does not teach a instant message module (see Final Office Action, p. 5). The Examiner suggests,

however, that this claimed feature is taught by Liversidge. See id. Specifically, the

Examiner relies on ¶[0073] which states "an instant messaging server 84 which

interacts with the collaboration manager 76 to provide specialized services with respect

to the management and control of instant messaging sessions." Even if this is true, the

Liversidge reference is silent regarding identity-based activities, much less sending

indications of such activities to at least one peer. The Examiner has attempted to

combine a reference that teaches the use of an instant messaging application in a

"Virtual Team Environment" (VTE) in order to account for the claimed feature of an

instant messaging module, communicatively coupled to the content daemon, to send an

indication of identity-based activity to at least one peer, the identity-based activity

related to a user logged-in to the instant messaging module. Clearly, as Liversidge is

silent regarding this feature, the combination of this reference with the teachings of

Briggs is not proper. The Examiner appears to be using the claims as a roadmap to

combine the two prior art references in order to custom-fit the claims. Essentially, the

Examiner has used improper, pure hindsight reasoning to incorporate only the teaching

of an instant messaging module into a claim feature that also requires the instant

messaging module to be communicatively coupled to the content daemon, to send an

indication of identity-based activity to at least one peer, the identity-based activity

related to a user logged-in to the instant messaging module. In other words, adding the

disclosure of Liversidge does not make up for the deficit of Briggs.

In Response: In order to clarify the examiner's position, examiner respectfully would

like to point out that module can be software since it was never clearly defined and had

limited supported in the specifications. The explanation of an instant messaging module

found in the specification is vague and can be considered numerous of things.

Application states "centralized messenger service may be Apple Computer Inc.'s iChat

TM, America Online's AIM TM, an instant messaging module or the like." p. 12, [38]

lines 15-16. This does not specify that the instant messaging module is actually a

centralized messenger service.   Thus, examiner views instant messaging module is

viewed as software. Prior Art Briggs standing alone without Liversidge teaches logged-

in to the instant messaging module, along with other claim limitations.   This is explained

by Briggs "*Fig. 2 is a user interface for logging in or creating a new account.*"; Column 1

lines 41-42. Further Briggs discloses *"For enterprise applications, registration may be*

handled by a system administrator and integrated or coordinated with registration for

network login, e-mail or other messaging"; Column 17 lines 49-53. These logins allows

for access of *instant message tools 134*, depicted in *Brigg's Fig 1 element 134*. All of

these can be considered an instant messaging module. These are part of the invention

which is coupled with Brigg's activity viewer database (AVD). This is disclosed by Briggs

"each matched entry is added 1627 to the corresponding shared users file within the

activity viewer database ("AVD") 1610"; Column 13 lines 34-38). Briggs activity viewer

database (AVD) explains applicant's content daemon. Finally Briggs disclosing

"buddies identified on buddy lists of instant messaging products can share selected

aspects of their computer usage experiences"; Column 2 lines 28-30. Briggs discloses

"aggregation tools and processes assemble statistics about user experiences across

different bases, such as buddy lists, categories of users, and all service participants";

Page 2 lines 38-41.   This teaches to send an indication of identiy-based activity to at

least one peer, the identity-based activity related to a user logged-in to the instant

messaging module. Therefore without a further reference, Briggs alone teaches the

limitations disclosed in claims 1, 14, 26, and 38.

(C.2) Argument regarding claim 4: The Examiner Failed to Prove a Prima Facie Case

of Obviousness of Claim 4 over Briggs in view of Liversedge

Other pending claims are allowable for additional features recited therein. For instance,

claim 4, which depends from claim 1, teaches sharing identity-based activity comprising

instances of active content by a user logged-in to the instant messaging module. Active

content includes files that a user is currently accessing, such as music files the user is

currently listening to, movies the user is currently watching, or the like. See Application,

p. 2, 11. 14-16. Sharing active content allows the user to communicate current activity in

real-time. The Briggs reference at least does not teach the claimed feature of sending

an indication of identity-based activity, wherein identity-based activity comprises

instances of active content by a user logged-in to the instant messaging module. The

whole idea behind the subject matter described in Briggs is that you can rate and

comment on web content before you share with your "buddies." See Briggs, col. 2, 11.

51-55 (stating "[A] user could visit a web site, listen to or watch content, rate a site or

content, assign an emoticon or quick comment to a site or content, send or bookmark a

site or content or download data; a VUD entry could result." [emphasis added]). It can

only be concluded that Briggs does not teach the sending of an indication of active

content.

In the Office Action, the Examiner argues that the claimed feature of "sending active

content" is taught by Briggs in Col. 7, 11.42-44. See Office Action, p. 4. Appellant

respectfully disagrees. The cited passage from Briggs describes sending previously

stored information to another user. In particular, Briggs teaches sending a stored item,

item link, or item information to a "buddy" who has enrolled to share data. See Briggs,

col. 7, 11.42-44; co1.19, 11. 5-6; col. 18, 11. 38-57. For example, a user in Briggs may

choose to send a "buddy" an item from a list of previously visited websites. See Briggs,

Fig. 9. As such, Briggs discloses the sharing of past activities and experiences with

other "buddies." In contrast, Claim 4 calls for sending an indication of identity-based

activity, wherein identity-based activity comprise instances of active content by a user

logged-in to the instant messaging module.

Furthermore, the Examiner has admitted that Briggs does not teach an instant

messaging module. See Specification, p.5. Thus, Briggs cannot teach the claimed

feature of identity-based activity comprises instances of active content by a user logged-

in to the instant messaging module. As stated above with respect to claim 1, Liversidge

does not teach any instances of active or identity-based content. For at least these

reasons, the Examiner failed to show a prima facie case of obviousness of claim 4, and

as such, claim 4 is allowable. Accordingly, claims 5, 17-18 and 29-30 are also allowable

for the same reasons claim 4 is allowable.

In Response: Examiner would like to clarify position regarding applicant's argument of

claim 4. Applicant's argument is the identity-based activity comprises instances of

active content, and the active content is thought not to be taught by Briggs. Applicant

makes argument that active content includes files that a user is currently accessing,

such as music files the user is currently listening to. Examiner respectfully disagrees

and also points to Briggs disclosing *"A VUD stores URL's visited by users, or by*

participants. More generally, a user could visit a web site, listen to or watch content,

rate a site or content, assign an emoticon or quick comment to a site or content, send or

bookmark a site or content or download data; a VUD entry could result." Column 2 lines

50-55." This is viewed by examiner as identity based activity with active content. Once

the URL is shared with other users, other users can see or listen to music files user is

currently accessing. Also as explained above, Briggs also teaches an instant

messaging module.

(C.3) Argument regarding claims 8, 9, 11, 23, 29, 35: Claim 8 is also allowable for

features recited therein. Claim 8, which depends from claim 1, calls for the content

daemon to detect and store identity-based activity after logging-in the user to the instant

messaging module, and wherein the instant messaging module sends an update to the

identity-based activity. As described in the instant Application, by using an instant

messaging module for sharing, users can share real-time content and files with other users, not just "static files" stored on the computer.

See Application, ¶[0006] & ¶[0027]. Briggs discloses a log-in screen from which a user may log-in or create a new account. Specifically, Briggs shows a log-in screen for the "fatbubble®" program, not an instant messaging module as taught in claim 8. See Briggs, Fig. 2. In fact, Briggs teaches that the interface used to send content to "buddies" is an administrative tool used to select "buddies'" options and send files, it is not an instant messaging module used for instant messaging and sharing content post. Furthermore, the Examiner has admitted that Briggs does not teach an instant messaging module. See Specification, p.5. In contrast, claim 8 teaches the feature of content daemon to detect and store identity-based activity after logging-in the user to the instant messaging module.

With respect to the claimed feature of sends an update to the identity-based activity, the Examiner cites Briggs, col. 7, 11.64-65, (even though this reference does not teach an instant messaging module that performs the sending feature) as teaching "columns provided...include a tick box 852, a buddy name 853, and one or more instant messaging contact links 854." See Final Office Action, p.8. Appellant respectfully asserts that the cited passage does not teach identity based activity, as understood from a reading of the claims and the specification.   As a non-limiting, illustrative example, identity based activity may include web auctions, other web- based transactions, and the like. See Specification, p.2, 11.9-19. As noted above, Liversidge also does not disclose the identity based activity described above.

In Response: Examiner respectfully would like to clarify position regarding applicant's argument. Appellant makes claim that Briggs shows a log-in screen for the "fatbubble" program, not an instant messaging module as taught in claim 8. Appellant further explains as described in the instant Application, by using an instant messaging module for sharing, users can share real-time content and files with other users, not just "static files" stored on the computer, and refers to Application, [0006] & [0027]. Examiner does not see anywhere in these two paragraph where it states instant messaging module being used for sharing, users can share real-time content and files with other users. Examiner as explained previously see's applicant's instant messaging module as being software, since examiner does not see instant messaging module being supported in the specifications.   As so, examiner views Briggs teaches wherein the content daemon detects and stores identity-based activity, after logging-in the user to the instant messaging module and wherein the instant messaging module sends an update to identity based activity. For logging-in to software which is associated with instant messaging, Briggs discloses: *"Fig. 2 is a user interface for logging in or creating a new account.";* Column 1 lines 41-42. Further Briggs discloses *"For enterprise applications, registration may be handled by a system administrator and integrated or coordinated with registration for network login, e-mail or other messaging";* Column 17 lines 49-53. This software log in allows for the association of *instant message tools 134*, depicted in Brigg's Fig 1 element 134. The instant messaging tool is used to interact with other instant messaging partners or buddies. These buddies are associated with identity-

based activity. For teaching the content daemon detecting and storing identity-based

activity. *Briggs discloses each matched entry is added 1627 to the corresponding*

shared users file within the activity viewer database ("AVD") 1610. The system

populates activity viewers of logged-in users by pulling entries from the AVD 1628. User

ID, action, item, location, category, rating, emoticon, comment, time, or other relevant

field may filter the displayed data from the AVD; Column 13 lines 34-40. Briggs further

discloses an activity viewer database ("AVD") 1610 can store information associating

particular users with URLs, locations or items. Raw data regarding user activity is

filtered and matched with entries from the VUD, VLD or visited item database to create

the AVD; Column 4 lines 4-10. Respectfully this is viewed to examiner as teaching

Identity-based activities. A URL is a location of a web site which can be in use at any

time by identified users.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Gerald Smarth/

Examiner, Art Unit 2446

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2446

Conferees:

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2446

/Bunjob Jaroenchonwanit/

Supervisory Patent Examiner, Art Unit 2456